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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,831	03/30/2004	Santosh Pasha	U 015119-4	3116

140 7590 01/23/2007
LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER

KOSAR, ANDREW D

ART UNIT	PAPER NUMBER
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1654

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/812,831

Applicant(s)

PASHA ET AL.

Examiner

Andrew D. Kosar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006 and 31 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7-9 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) 2,9,18-23 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 25,27,28 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments/Amendments

Applicant's amendments and arguments filed October 25, 2006 and October 31, 2006 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed is herein withdrawn.

Applicant has added new claims 28-31.

With regards to the new claims, claim 28 is a new claim drawn to a subgenus previously indicated as allowable subject matter. Claim 30 is a recitation of canceled claim 5, which is recites the elected invention and additional inventions as set forth in the original restriction requirement. New claim 29 is a subgenus of Xaa, which defines compounds structurally distinct from the elected species and that which has been search by the examiner, and thus because there is nothing of record to show they are obvious variants of the elected species, they are considered to be nonelected species.

Claims 2, 9, 18-23 and 29 are/remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 3, 2006.

In the interest of compact prosecution, the examiner has included new claim 31, as set forth below and has extended the search to included the species of claims 25 and 27. Please note, because claim 31 does not *per se* require the Orn-Pro core, it has been treated as a generic linking claim and has been rejected as such.

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Claims 25, 27, 28 and 30 are objected to for the following informality:

Claims 25, 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 30 recites non elected invention, e.g. groups (b), (c), (d), etc. It is noted that group (a) is commensurate in scope with claim 28.

Assuming *arguendo* that Applicant amends claim 30 to recite only the elected invention and amends claims 25 and 27 as required, Applicant is advised that should claim 25 be found allowable, claim 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof and/or should claim 28 be found allowable, claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7, 8, 24 and 26 remain rejected under 35 U.S.C. 102(b) as anticipated by ONDETTI.

Applicant argues that Ondetti does not anticipate or render obvious the instantly claimed compounds and that the peptide identified by the examiner is not within the instantly claimed genus. Respectfully, the examiner disagrees.

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The instant claims are drawn to compounds having the sequence Xaa-AA₁-AA₂, which is quite different than the compounds of new claim 31 compounds consisting of the sequence Xaa-AA₁-AA₂, which only allows for tripeptides. Nothing in the instant claims precludes peptides of longer length.

Thus, the peptide pGlu-Trp-Pro-Orn-Pro-(Nle,Gln)-(Ile,Phe)-Pro-Pro, as taught by Ondetti (claim 9), as well as the peptides identified in the specification (compounds 82-85) anticipate the instant claims.

Claims 1, 7, 8 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by KONDOU (GB 2,144,128 A).

Kondou teaches the peptide pGlu-Glu-Ala, which is a tripeptide consisting of an 'unusual' or 'heterocyclic' amino acid, pGlu and two amino acids Glu and Ala. Because it meets the structural limitation of the claims, it must necessarily have the requisite activity and properties, e.g. IC₅₀.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


This application contains claims 2, 9, 18-23, 25, 27 and 29 drawn to an invention nonelected without traverse on April 3, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew D. Kosar whose telephone number is (571)272-0913. The examiner can normally be reached on Monday - Friday 08:00 - 16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew D. Kosar, Ph.D.
Patent Examiner
Art Unit 1654


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